

REMARKS

As a preliminary matter, Applicants affirm the election of claims 201-234 made during a telephone call with the Examiner on March 6, 2007. Accordingly, Applicants have cancelled claims 1-200 and 235-266.

In the Office Action mailed on April 4, 2007, the Examiner rejected all of the pending claims. In particular, the Examiner rejected claims 201, 205-207, 209, 212, 214-217, 221-223, 225, 228, and 230-234 under 35 U.S.C. § 102(e) as being anticipated by *Kahn et al.*, U.S. Patent No. 6,401,079. Furthermore, the Examiner rejected claims 208, 210-211, 213, 224, 226-227, and 229 under 35 U.S.C. § 103 as being unpatentable over *Kahn et al.* in view of Official Notice taken by the Examiner. The Examiner also rejected claims 202-204 and 218-220 under 35 U.S.C. §103 as being unpatentable over *Kahn et al.* in view of *Embrey*, U.S. Patent No. 6,311,170. Finally, claims 201-234 have been rejected on the grounds of non-statutory obviousness-type double patenting over claims 1-48 of U.S. Patent No. 5,946,669 and claims 1-70 of U.S. Patent No. 6,119,107. Because these patents are currently undergoing reexamination, Applicants defer responding to the double patenting rejections until the present claims are found otherwise allowable.

By this Amendment, Applicants have amended claims 201, 217, 233, and 234 to correct typographical errors and clarify aspects of the invention. In addition, claims 1-200 and 235-266 have been cancelled, without prejudice or disclaimer. Claims 267-268 have been added. Therefore, claims 201-234 and 267-268 are pending.

Section 102 Rejections

The Examiner rejected claims 201, 205-207, 209, 212, 214-217, 221-223, 225, 228, and 230-234 under 35 U.S.C. § 102(e) as being anticipated by *Kahn et al.* To anticipate a claim, the reference must teach every element of the claim. M.P.E.P. § 2131.01 (8th ed. 2001, revised August 2006). As amended, these claims recite elements not taught in *Kahn et al.* and Applicants therefore request the reconsideration and withdrawal of the section 102 rejections.

Amended claim 201 recites a method for processing payments over a network for a plurality of intermediaries including, among other things, receiving employee information from a plurality of employers via the network, the employee information corresponding to at least one employee of each employer and including an intermediary identifier; processing at least one employee debit corresponding to the employee information for each employee; processing a credit corresponding to each employee debit; batching the credits into a plurality of batch files based upon the intermediary identifier, **each batch file including intermediary-requested data**; and sending each batch file, **including the intermediary-requested data**, to an intermediary based on the intermediary identifier. *Kahn et al.* does not teach this combination of steps.

Instead, *Kahn et al.* discloses a system which “generates[s] disbursement information for payments to employees/contractors, benefit providers, miscellaneous payees, and various tax authorities.” (*Kahn et al.*, col. 6 ll. 3-5.) Furthermore, the system includes a “payee type for [for each payee], as selected from pull-down menu 4000” that is “used to define the report sent to the payee along with the disbursement”

(*Id.*, col. 39 ll. 17-19.) The type of report sent to a payee in the system of *Kahn et al.* is based upon a payee's payee type (i.e. child support agency, medical insurance, or mortgage lender). (See, e.g., *Id.* col. 39 ll. 20-21 and Fig. 24(a).)

Unlike the system described in *Kahn et al.*, the method of claim 1 includes the steps of receiving employee information from a plurality of employers via the network, the employee information corresponding to at least one employee of each employer and including an intermediary identifier; processing at least one employee debit corresponding to the employee information for each employee; processing a credit corresponding to each employee debit; batching the credits into a plurality of batch files based upon the intermediary identifier, **each batch file including intermediary-requested data**; and sending each batch file, **including the intermediary requested data**, to an intermediary based on the intermediary identifier.

Thus, in the embodiments of claim 201, each intermediary may request data to be sent with its batch files, regardless of what other intermediaries of the same type request. (See, e.g., Specification ¶ 0189.). Because the reference does not teach each and every element of amended claim 201, Applicants request the reconsideration and withdrawal of the section 102 rejections of claim 201 and its dependent claims 202-216.

Amended independent claim 217 recites a system for processing payments over a network for a plurality of intermediaries comprising, among other things, a first receiving component configured to receive employee information from a plurality of employers via the network, the employee information corresponding to at least one employee of each employer and including an intermediary identifier; a first processing

component configured to process at least one employee debit corresponding to the employee information for each employee; a second processing component configured to process a credit corresponding to each employee debit; a batching component configured to batch the credits into a plurality of batch files based upon the intermediary identifier, **each batch file including intermediary-requested data**; and a sending component configured to send each batch file, **including the intermediary-requested data**, to an intermediary based on the intermediary identifier. As discussed above with reference to claim 201, *Kahn et al.* does not disclose a component that sends a batch including intermediary-requested data to the intermediary. Since *Kahn et al.* does not teach each and every element of the claims, the reference cannot anticipate these claims. Accordingly, Applicants request the reconsideration and withdrawal of the section 102 rejections of claim 217 and its dependent claims 218-232.

Amended independent claim 233 recites a tangible computer-readable medium which stores a set of instructions which when executed perform a method comprising, among other things, a receiving module configured to receive employee information from a plurality of employers via the network, the employee information corresponding to at least one employee of each employer and including an intermediary identifier; a first processing module configured to process at least one employee debit corresponding to the employee information for each employee; a second processing module configured to process a credit corresponding to each employee debit, a batching module configured to batch the credits into a plurality of batch files based upon the intermediary identifier, **each batch file including intermediary-requested data**;

and a sending module configured to send each batch file, **including the intermediary-requested data**, to an intermediary based on the intermediary identifier. As discussed above with respect to claim 201, *Kahn et al.* does not disclose these steps. Accordingly, Applicants request the reconsideration and withdrawal of the section 102 rejection of claim 233.

Amended independent claim 234 recites a system for processing payments over a network for a plurality of intermediaries comprising, among other things, means for receiving employee information from a plurality of employers via the network, the employee information corresponding to at least one employee of each employer and including an intermediary identifier; means for processing at least one employee debit corresponding to the employee information for each employee; means for processing a credit corresponding to each employee debit; means for batching the credits into a plurality of batch files based upon the intermediary identifier, **each batch file including intermediary-requested data**; and means for sending each batch file, **including the intermediary requested data**, to an intermediary based on the intermediary identifier. As discussed above with respect to claim 201, *Kahn et al.* does not disclose this subject matter. Accordingly, Applicants request the reconsideration and withdrawal of the section 102 rejection of claim 234.

Section 103 Rejections

The Examiner rejected claims 202-204 and 218-220 as being unpatentable over *Kahn et al.* in view of *Embrey*. Applicants respectfully traverse these rejections because a *prima facie* case of obviousness has not been established.

To support a *prima facie* case of obviousness under 35 U.S.C. § 103(a), the reference, taken alone or combined, must teach or suggest each and every element recited in the claims. M.P.E.P. § 2143.03 (8th ed. 2001, revised August 2006). Furthermore, as the Deputy Commissioner for Patent Operations recently confirmed, “in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.” May 3, 2007 U.S.P.T.O. Memorandum from Margaret A. Focarino.

Claims 202-204 recite elements that are neither taught nor suggested by the cited references. Even if the Examiner is able to identify a reason why a skilled artisan would combine the cited references (which Applicants do not concede), the cited references in combination still would not disclose or suggest the claimed invention. Accordingly, Applicants request the continued examination of the claims and the withdrawal of the section 103 rejections.

For example, claims 202-204 depend from claim 201 and therefore indirectly recite receiving employee information from a plurality of employers via the network, the employee information corresponding to at least one employee of each employer and including an intermediary identifier; processing at least one employee debit corresponding to the employee information for each employee; processing a credit corresponding to each employee debit; batching the credits into a plurality of batch files based upon the intermediary identifier, each batch file including intermediary-requested data; and sending each batch file, including the intermediary-requested data, to an

intermediary based on the intermediary identifier. As discussed above with respect to claim 201, *Kahn et al.* does not teach this combination of steps. *Embrey* does not cure this defect. Instead, *Embrey* is merely cited for teaching the step of verifying employee information using verification information received from an intermediary. *Kahn et al.* and *Embrey*, alone or in combination, do not teach or suggest every element of claims 202-204, even if the Examiner could show a reason to combine these references. Because no *prima facie* case of obviousness has been established, Applicants request the reconsideration and withdrawal of the section 103 rejections of these claims.

Even if *Kahn et al.* did teach the sending of intermediary-requested data, the combination of *Embrey* and *Kahn et al.* does not teach or suggest every element of claims 202-204. Although *Embrey* was cited for teaching the step of verifying employee information using verification information received from an intermediary, it does not teach this. Instead, *Embrey* teaches that a “trusted intermediary financial institution” verifies whether the amount and payee on a payment matches the amount and payee requested by the payor. (*Embrey*, col. 3 ll. 47-55). The verification merely verifies that the payment amount or payee has not been changed. (*Id.* col. 4 ll. 55-63). For this reason *Embrey* fails to teach verifying the employee information using verification information received from an intermediary, and for this additional reason, the combination of *Embrey* and *Kahn et al.* would not teach every element of claims 202-204. Therefore, Applicants request the reconsideration and withdrawal of the section 103 rejections of these claims.

Finally, claims 218-220 depend from claim 217 and therefore indirectly recite a system for processing payments over a network for a plurality of intermediaries comprising, among other things, a first receiving component configured to receive employee information from a plurality of employers via the network, the employee information corresponding to at least one employee of each employer and including an intermediary identifier; a first processing component configured to process at least one employee debit corresponding to the employee information for each employee; a second processing component configured to process a credit corresponding to each employee debit; a batching component configured to batch the credits into a plurality of batch files based upon the intermediary identifier, each batch file including intermediary-requested data; and a sending component configured to send each batch file, including the intermediary requested data, to an intermediary based on the intermediary identifier. For the reasons set forth above with reference to claims 202-204, *Kahn et al.* and *Embrey*, alone or in combination, do not teach or suggest every element of claims 218-220, so no *prima facie* case of obviousness has been established. Therefore, Applicants request the reconsideration and withdrawal of the section 103 rejections of these claims.

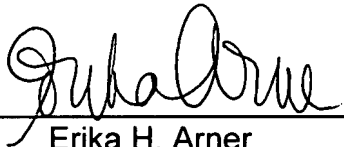
In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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